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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,333	11/30/2000	Krishnamurthy Srinivasan	10559/362001/P10096	3828
20985	7590	07/22/2004	[REDACTED]	EXAMINER
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			[REDACTED]	DAS, CHAMELI
			[REDACTED]	ART UNIT
			[REDACTED]	PAPER NUMBER
			2122	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	JW
	09/734,333	SRINIVASAN ET AL.	
Examiner	Art Unit		
CHAMELI C. DAS	2122		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 May 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-27 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

1. This action in response to the amendment filed on 5/14/04.
2. Claims 1-2, 4, 5-6, 10-23, 24, 26-27 have been amended.
3. Claim 23 has been canceled.
4. Claims 1-22 and 23-27 have been rejected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Claims 1-22, 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 1, 4, 6, 12-16, 19, 20, 22, 26-27 contain the trademark/trade name "JAVA". When a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112 second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe object and , accordingly, the identification/description is indefinite.

As per Claims 2, 10, 11, 17-19, 21, 26 contain the trademark/trade name "JINI". When a trademark or trade name is used in a claim as a limitation to identify or describe a particular

material or product, the claim does not comply with the requirements of 35 U.S.C. 112 second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe broker and , accordingly, the identification/description is indefinite.

Claims 3, 5, 7-9 are the dependent claims of the above claims and recite the same limitations.

Response to Arguments

6. Applicant's arguments filed on 12/29/03 have been fully considered but they are not persuasive.

In the remark, the applicant has argued in substance:

(1) Neither Alcorn nor Nevarez disclose publishing the information.

Response:

As per claim 1, Alcorn discloses the method of distribution of the information of the wrapped object (Java object) with a broker (CORBA), see col 5, lines 5-65. Alcorn does not specifically disclose "publishing". However, Nevarez discloses publishing the information is shown in ABSTRACT and (col 4 lines 15-27). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention was made to incorporate the teaching of Nevarez into the method of Alcorn. The modification would be obvious because one of the ordinary skill

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in the art would be motivated to allow other workstations in a network to distribute the information of the wrapped object efficiently.

- (2) Neither Alcorn nor Nevarez disclose publishing this with a broker.

Response:

(2) Alcorn discloses distribute the information with a broker (col 5, lines 52-60, “a customize is provided to allow a user building a ***distributed*** application to configure a host name or the Internet Protocol (IP) address of the second tier computer implementing the server side DAP, server object 402. In this example, a Java remote method invocation (RMI) protocol is employed for ***distributed*** communication between objects, such as client object 400 and server object 402. Of course the present invention may be implemented equally well with other types of distributed protocols, such as, for example, the ***Common Object Request Broker*** Architecture (CORBA) standard designed by the Object Management Group consortium. ***CORBA*** details an object bus that lets objects communicate across enterprises and even continents. It's an Internet done with objects for objects. CORBA was designed to allow intelligent components to discover each other and inter-operate on an object bus. However, CORBA goes beyond just inter-operability.”).

Nevarez discloses the publishing information. See the response of argument 1 above.

- (3) Alcorn does not disclose automatically searching for functionality of said non JAVA object.

Response:

(3) Alcorn discloses searching for functionality of another class (non JAVA class) (col 8, lines 1-3), “The creation of a new subclass borrowing the functionality of another class allows software developers to easily customize existing code to meet their particular needs” ,

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inherently including searching for functionality as claimed. Alcorn does not specifically disclose “*automatic* searching”. Official notice is taken for *automatic* search. The modification would be obvious because one of the ordinary skill in the art would be motivated to reduce or eliminate human intervention to complete a task.

(4) As per claim 26, Alcorn does not disclose “providing JAVA or non-JAVA service to a broker that publishes information”.

Response:

Alcorn discloses “providing JAVA or non-JAVA service to a broker that distribute information”. (col 5, lines 5-60) and Nevarez discloses the method of publishing information. See the response of argument 1 above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chameli Das whose telephone number is (703) 305-1339. The examiner can normally be reached on Monday through Friday from 7:00 A.M to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 703-305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 (official fax).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

**CHAMELI C. DAS
PRIMARY EXAMINER**

Chameli C. Das

**CHAMELI C. DAS
PRIMARY EXAMINER**

7/14/04

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